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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,705	10/20/2000	Simon Robert Walmsley	NPA053US	7415

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

MARC COLEMAN, MARTHE Y

ART UNIT PAPER NUMBER

3661

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/693,705

Applicant(s)

WALMSLEY ET AL.

Examiner

Marthe Y Marc-Coleman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This is a first office action in response to amendment filed on July 26, 2002.

#### *Specification*

2. The specification is objected to because of the following informality:

(e) **the "Stephen B. Wicker, Error Control Systems for Digital Communication and Storage, Prentice-Hall 1995" on page 15 lines 25-27 of the specification is not considered because a copy of such document is not submitted;**

Correction is required.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which **was not described in the specification** in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), **at the time the application was filed**, had possession of the claimed invention.

In regard to claims 1-5, "the map of the geographic area and the coded data being printed substantially simultaneously" is not in the specification;

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In regard to claims 1-5, "the map of the geographic area and the coded data being printed substantially simultaneously" is not in the specification;

"generating the indicating data based at least partially on sensing at least some of the coded data in the vicinity or the position" is not in the specification.

In regard to claims 6-10, "the printer being adapted to print the map and the coded data substantially simultaneously" is not in the specification";

"generating the indicating data based at least partially on sensing at least some of the coded data in the vicinity or the position" is not in the specification.

In regard to claims 11-12, "comprising a non-electronic printed surface displayed coded data" is not in the specification.

"generating the indicating data based at least partially on sensing at least some of the coded data in the vicinity or the position" is not in the specification.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1 -10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conroy et al. (U.S. Patent No. 5,686,705) in view of Dymetman et al. (Intelligent Paper; in Electronic Publishing Artistic Imaging, and Digital Typography).<sup>1</sup>

In regard to claim 1, Conroy et al. discloses a method of enabling a user to designate, in a computer system (**30 in Fig. 1**), at least one geographic location ( or point of interest P in Fig. 2) (see col. 18 lines 44-52), the method including the steps of:

- receiving in a computer system (**which is processor 30**) indicative data from a sensing device (**stylus 20**) operated by the user (see abstract and col. 8 lines 55-58), the indicative data regarding the identity of the map (see Fig. 4 items 114A, 114B and col. 12 lines 20-30) and a position of the sensing device relative to the map (which corresponds to the position of the stylus 20 relative to the surface 10 wherein surface 10 is considered to be a map see also col. 12 lines 20-30), the sensing device when placed in an operative position relative to the map *generating the indicating data based at least partially on sensing at least some of the coded data in the vicinity of the position* (see col. 12 lines 20-22 and Figs. 2 and 4) ( the geographical location represented by a unique combination of x and y coordinates, are coded and stored at specific addresses in the microprocessor see col. 9 line 20-23 and col. 10 lines 56-65); and
- identifying in the computer system and from the indicating data the at least one geographic location (**p**) (see abstract; col. 3 lines 18-27; and col. 8 lines 55-60).

Conroy et al. also discloses a map including coded data indicative of an identity of the map and a plurality of reference points **P<sub>x</sub>** and **P<sub>y</sub>** of the map (whose geographical location represented by a unique combination of x and y coordinates, are coded and stored at specific addresses in the microprocessor (see col. 9 line 20-23 and col. 10 lines 56-65).

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<sup>1</sup> The Intelligent Paper is dated March/April 1998.

Although Conroy et al. discloses a map included coded data, and a printer, Conroy et al. fails to specifically disclose printing a map, including coded data; the map of the geographic area and the coded data being printed substantially simultaneously.

Dymetman et al., on the other hand, discloses printing a map of a geographic location with coded data (see page 396 section 3, Technology wherein a map of Europe is printed on Intelligent paper having two layers of ink and printed on the paper support. The first layer, is the coded layer printed in invisible ink and the second layer is printed in conventional colored inks and is visible to the user).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to utilize Dymetman et al.'s map printed on intelligent paper with coded data with Conroy et al.'s position locating method because it would provide an interactive map information exchange wherein a user would be able to perform similar function on a printed map as he would on screen.

**In regard to claim 2, Conroy et al. discloses:**

- receiving in the computer system, movement data regarding movement of the sensing device relative to the map (see col. 13 lines 16-18), the sensing device sensing its movement relative to the map using at least some of the coded data (see col. 13 lines 16-18 and col. 9 lines 2-23 and Fig. 2).
- Identifying in the computer system and from the movement data a geographical region (see col. 13 lines 16-19; col. 13 lines 53-63; and col. 18 lines 43-52).

In regard to claim 6, Conroy et al. discloses a system for enabling a user to designate, in a computer system (**30**), at least one geographic location ( which corresponds to the point of interest see col. 8 lines 55-60; col. 10 lines 60-65; col. 18 lines 44-52), the system including:

- a map of a geographic area (the geographical area corresponds to the surface 10 in Figs. 1 and 2) (see col. 5 lines 20-21; col. 19 lines 58-67; and col. 13, lines 59-60 also see abstract) , the geographic area including the at least one geographic location (col. 8 lines 55-60 and Figs. 1 and 2), the map including coded data indicative of an identity of the map and a plurality of reference points **P<sub>x</sub>** and **P<sub>y</sub>** of the map (whose geographical location represented by a unique combination of x and y coordinates, are coded and stored at specific addresses in the microprocessor (see col. 9 line 20-23 and col. 10 lines 56-65).
- a computer system (**which is processor 30**) for receiving indicative data from a sensing device (**stylus 20**) operated by the user (see abstract and col. 8 lines 55-58) , the indicative data regarding the identity of the map (see col. 9 lines 20-47) and a position of the sensing device relative to the map (which corresponds to the position of the stylus 20 relative to the surface 10 wherein surface 10 is considered to be a map see also col. 12 lines 20-30), the sensing device when placed in an operative position relative to the map *generating the indicating data based at least partially on sensing at least some of the coded data in the vicinity of the position* (see col. 12 lines 20-22 and Figs. 2 and 4) ( the geographical location represented by a unique combination of x and y coordinates, are coded and stored at specific addresses in the microprocessor see col. 9 line 20-23 and col. 10 lines 56-65); and

wherein the computer system is configured to identify from the indicating data the at least one geographic location (**p**) (see abstract and col. 3 lines 18-27 and 8 lines 55-60).

Although Conroy et al. discloses a map included coded data, and a printer, Conroy et al. fails to specifically disclose a printer to actually print a map, including coded data.

Dymetman et al. discloses a printer for printing the map including the coded data on demand, the printer being *adapted to print the map and the coded data substantially simultaneously* ( on page 396 section 3, Technology, a map of Europe is printed on Intelligent paper wherein two layers of ink are printed on the paper support. The first layer, is the coded layer printed in invisible ink and the second layer is printed in conventional colored inks and is visible to the user).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to utilize Dymetman et al.'s map printed on intelligent paper with coded data with Conroy et al.'s position locating system because it would provide an interactive map information exchange wherein a user would be able to perform similar function on a printed map as he would on screen.

**In regard to claim 7**, Conroy et al. discloses that the sensing device sensing its movement relative to the map using at least some of the coded data; wherein the computer system is configured to identify, from said movement, a geographic region (see col. 13 lines 16-18; col. 18 lines 31-52 and Figs. 11 and 12).

**In regard to claims 3 and 8**, Conroy et al. discloses the map contains geographic features of the geographic area (see col. 18 lines 44-52).



**In regard to claim 4**, although Conroy et al. discloses that when a map control is designated to the user using the sensing device, performing, in the computer, an action associated with the map (in col. 8 lines 55-60), Conroy et al. fails to specifically disclose the step of printing at least one map control.

Dymetman et al., on the other hand, discloses the step of printing at least one map control (by printing a keyboard on page 400 in the hotel reservation section). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to utilize Dymetman's map printed on intelligent paper with coded data with Conroy's position locating method because it would provide an interactive map information exchange wherein a user would be able to perform similar function on a printed map as he would on screen.

**In regard to claims 5 and 10**, Conroy et al. meets the limitations of claims 4 and 9, but fails to disclose that the action is one of printing a map of a designated geographic region.

Dymetman et al. discloses that the action is one of printing a map of a designated geographic region (see Europe map on page 396 Technology).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to utilize Dymetman et al.'s map printed on intelligent paper with coded data with Conroy et al.'s position locating method/system because it would provide an interactive map information exchange wherein a user would be able to perform similar function on a printed map as he would on screen map.

**In regard to claim 9**, Conroy et al. discloses a map control page including at least one printed map control (see col. 5 lines 12-22 and col. 19 lines 55-57); wherein the computer system is configured to an action associated with the map control when the map control is designated by the user using the sensing device (see abstract lines 22-28 and col. 8 lines 55-60).

### ***Response to Arguments***

7. Applicant's arguments filed on 7/26/02 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marthe Y Marc-Coleman whose telephone number is (703) 305-4970. The examiner can normally be reached on Monday-Thursday from 9:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A Cuchlinski can be reached on (703) 308-3873. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Patent Examiner

*MYM*

Marthe Marc-Coleman



WILLIAM A. CUCHLINSKI, JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

September 19, 2002